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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,199	10/22/2003	Peter Mardilovich	100204895-1	5652
22879	7590	08/14/2006	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			BELL, BRUCE F	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,199

Applicant(s)

MARDILOVICH ET AL.

Examiner

Bruce F. Bell

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: <u>7/27/06</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-33 and 44-46, drawn to method of making a porous film, classified in class 427, subclass 180+.
 - II. Claims 34-38 and 42, drawn to a fuel cell, classified in class 429, subclass 33.
 - III. Claim 39, drawn to an electronic device, classified in class 180, subclass 65.3.
 - IV. Claims 40 and 41, drawn to a method of using a fuel cell, classified in class 429, subclass 13.
 - V. Claim 43, drawn to a catalytic member, classified in class 502, subclass 101.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to a method of making a porous film and a fuel cell respectively. The method of making a porous film of Invention I is not required in the Invention of group II. The porous film in Invention II can be made in a materially different way, since an apparatus relies on structure not on the process of making, such as by chemical etching the film in specific areas to render the film porous or by using materials in the composition that when subjected to chemical exposure, etch away specific constituents in the material to form the porous film.

Inventions I and III are directed to a method of making a porous film and an electronic device. The method of making a porous film is not required in the electronic device as set forth, since it is the final product not the method of making that is required in the instant group III invention. The porous film of Invention I could be made in the manner set forth above to make the film used in the electronic device.

Inventions I and IV are directed to a method of making a porous film and a method of using a fuel cell. The method of making a porous film is not required in the method of using a fuel cell. The method of using a fuel cell by connecting a fuel cell to an electrical load and an electrical storage device is not a requirement in the method of making a porous film.

Inventions I and V are directed to a method of making a porous film and a catalytic member. The method of making a porous film is not required for the catalytic member. The catalytic member can be made of a porous thin film that has any catalytic material on or in it which enhances the catalytic activity and does not have to be a porous film made by the process set forth by applicants, it can be made forming the film and then impregnating the catalytic material into it. The method of making the porous film does not require that the film be catalytic or that it enhance catalytic efficiency.

Inventions II and III are directed to a fuel cell and an electronic device. The fuel cell as set forth does not require a load or to be connected to an electronic device. The fuel cell as set forth has different utility in that it can be used in a car to power the alternator to charge the battery rather than an electronic device.

Invention II and IV are directed to a fuel cell and a method of using a fuel cell. The specifics of connecting the fuel cell to an electrical load and an electrical storage device is not a requirement in the fuel cell itself.

Inventions II and V are directed to a fuel cell and a catalytic member. The catalytic member as set forth has different utility in that it can be used in a battery or in a capacitor or in reformation of hydrocarbons.

Inventions III and IV are directed to an electronic device and a method of using a fuel cell. The electronic device as set forth is not required in the method of using a fuel cell as set forth.

Inventions III and V are directed to an electronic device and a catalytic member. The catalytic member as set forth is not required in the electronic device as set forth.

Inventions IV and V are direct to a method of using a fuel cell and a catalytic member. The catalytic member as set forth in the claims is not required in the method of using a fuel cell as set forth in the instant claims.

2. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

3. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

4. A telephone call was made to Ms. Julia Church Dierker on July 26, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.


5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce F. Bell whose telephone number is 571-272-1296. The examiner can normally be reached on Monday-Friday 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BFB
July 27, 2006


Bruce F. Bell
Primary Examiner
Art Unit 1746